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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,314	11/04/1999	PETER J. BLACK	PA000045	3810

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

LEE, JOHN J

ART UNIT PAPER NUMBER

2682

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

GA

Office Action Summary

Application No.

09/434,314

Applicant(s)

BLACK, PETER J.

Examiner

John J Lee

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: it is suggested that the spelling of the word "raw" in pages 6, lines 14 should be changed to "low" and "inventino" in pages 6, lines 34 should be changed to "invention".

Appropriate correction is required.

Claim Objections

2. **Claim 7** is objected to because of the following informalities: it is suggested that the word "to have to have" in lines 5 should be changed to "to have". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, it recites the limitation "said first base station" in lines 7 should be changed to "a first base station". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 1-4, 7-9, and 12** are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US Patent number 6154652).

Regarding **claim 1**, Park discloses that in a wireless communication system, a method for performing handoff comprising the steps of:

at a first station, determining when a handoff is necessary (Fig. 1, 3, 8, column 5, lines 15 – column 6, lines 44, abstract, and column 3, lines 45 – column 4, lines 17);

receiving a indication of link quality of signals transmitted by said first station (abstract, Fig. 1, 4, 7, 11, and column 7, lines 1 – column 9, lines 30); and

selectively performing said handoff when said indication of link quality of signals transmitted by a first base station (column 7, lines 1 – column 9, lines 30, abstract, Fig. 1, 4, 7, 11, and column 3, lines 45 – column 4, lines 17).

Regarding **claim 2**, Park discloses that the indication of the link quality comprises power control commands for controlling the transmission energy of said first station (column 7, lines 59 – column 9, lines 30 and abstract).

Regarding **claim 3**, Park discloses that the first station is a subscriber station and said step of selectively performing said handoff comprises the steps of (Fig. 1, 4, 7, 11):

selecting a base station to transmit to said subscriber station (column 12, lines 19 – column 13, lines 56 and Fig. 11);

determining in accordance with said indication of link quality whether signals transmitted by said subscriber station are of being received by said selected base station with sufficient energy (column 12, lines 19 – column 13, lines 56 and column 7, lines 59 – column 9, lines 30); and

performing handoff to said selected base station when said step of determining indicates that signals transmitted by said subscriber station are of

being received by said selected base station with sufficient energy (column 7, lines 1 – column 9, lines 30, abstract, Fig. 1, 4, 7, 11, and column 12, lines 19 – column 13, lines 56).

Regarding **claim 4**, Park discloses that the step of performing handoff comprises transmitting a message indicating the identity of said selected base station (column 12, lines 19 – column 13, lines 56 and column 7, lines 59 – column 9, lines 30).

Regarding **claim 7**, Park discloses all the limitation, as discussed above claims 1 and 3. Furthermore, Park further discloses that the determining that a base station used to communicate with said subscriber station continues to have the strongest signal received by said subscriber station (column 7, lines 1 – column 9, lines 30, abstract, Fig. 1, 4, 7, 11, column 12, lines 19 – column 13, lines 56, and column 3, lines 45 – column 4, lines 17);

forcing a handoff to an alternative base station when said step of determining indicates that signals transmitted by said subscriber station are not being received by said selected base station with sufficient energy (column 12, lines 19 – column 13, lines 56 and column 7, lines 1 – column 9, lines 30).

Regarding **claim 8**, Park discloses all the limitation, as discussed above claims 1 and 2.

Regarding **claim 9**, Park discloses all the limitation, as discussed above claims 1 and 2.

Regarding **claim 12**, Park discloses all the limitation, as discussed above claims 1 and 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 5-6, 10-11, and 13-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of I (US Patent number 6088335).

Regarding **claim 5**, Park does not specifically disclose the limitation "the message further indicates a requested rate of transmission by said selected base station". However, I discloses "the message further indicates a requested rate of transmission by said selected base station" (column 7, lines 5 – column 8, lines 45, abstract, Fig. 4, and column 1, lines 56 – column 2, lines 36). It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to provide the teaching of I to Park. The motivation relied upon performing handoff between mobile station and base stations in CDMA wireless system for proposing the motivation to provide more convenient controlling access to target network for handoff in order to further improve efficient power control in mobile communication system.

Regarding **claim 6**, Park and I disclose all the limitation, as discussed in claim 5. Furthermore, Park further discloses that the step of transmitting said message comprises spreading a message indicative of said rate by a spreading code selected in accordance with said selected base station (column 12, lines 19 – column 13, lines 56, column 10, lines 22 – column 11, lines 58, and column 7, lines 1 – column 9, lines 30).

Regarding **claim 10**, Park discloses all the limitation, as discussed above claims 1 and 2.

Regarding **claim 11**, Park discloses all the limitation, as discussed above claims 1 and 2.

Regarding **claim 13**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Regarding **claim 14**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Regarding **claim 15**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Regarding **claim 16**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Regarding **claim 17**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Regarding **claim 18**, Park and I disclose all the limitation, as discussed above claims 1 and 5.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee (US Patent number 6175736) discloses Providing a Power Efficient Soft Handoff in a Multicarrier CDMA Cellular System.

Willey (US Patent number 6104927) discloses Communication System, Mobile Station, and Method for Mobile Station Registration.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached on **(703) 308-6739**. Any inquiry of a general nature or relating to the status of this

application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
February 5, 2002

John J Lee



VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600